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EXAMINER

CHOUDHARY, ANITA

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/629,553

Applicant(s)

HAITSUKA ET AL.

Examiner

Anita Choudhary

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-21 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-13, 15, 16 and 22-29 is/are rejected.
- 7) ☒ Claim(s) 4, 14 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The amendment filed on September 21, 2004 has been entered. Claims 1, 10, 17, and 22 have been amended and are presented for further examination.

Claims 1-29 are presented.

Response to Arguments

Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

Claims 7 and 22 are objected to because of the following informalities:

Claim 7 line 5, the word "not" should be omitted.

Claim 22 line 3, there should be a comma placed between "online service" and "the system." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10, 15, 16, 22, and 25, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 10 recites the limitation "the window" in line 12, 15, and 16. There is insufficient antecedent basis for this limitation in the claim. It is not clear whether the window is meant to be the browser window of line 8 or the advertisement window of line 10 and 11.

Claim 15 recites the limitation "the client window" in line 3 (see also claim 16, line 3). There is insufficient antecedent basis for this limitation in the claim.

Claim 22 recites the limitations "the online server" in line 5 and "the client application" in lines 8-9. There is insufficient antecedent basis for these limitations in the claim.

Claim 25 recites the limitations "the play list" in line 2. There is insufficient antecedent basis for these limitations in the claim. This claim can be corrected by changing dependency from claim 22 to claim 24.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-13, 15, 16, 22-24, and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tazoe et al. (US 6,326,985) in view of Van Hoff et al. (US 5,959,623).

Tazoe show a system for detecting interaction within a predefined object/window. If the object/window is found to be in the inactive state, notification information is displayed. Tazoe shows:

- o A client application activating (col. 12 line 65- col. 13 line 3, col. 14 lines 45-47);

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- The client application establishing a communication channel from the local device to the online server (col. 8 lines 51-59);
- A browser application activating (col. 12 lines 58-63);
- The client application monitoring the user's interaction with the local device with respect to the client application (interaction with online service) and thereby detecting whether the user is interacting with the online service, wherein interaction is manipulating the input device (col. 14 lines 51-56, col. 15 lines 4-56);
- If the user has not interacted with the local device with respect to the client application for a predetermined time, the client application causing a dialog to be displayed on the output device of the local device, wherein the dialog notifies the user that the user has been idle with respect to the online server by displaying resource locator in the dialog (col. 15 lines 47- col. 16 line 8).

Although Tazoe shows substantial features of the claimed invention, Tazoe does not show *the client application causing at least one advertisement to be displayed on the output device of the local device*. Nonetheless this feature is well known in the art, and would have been an obvious modification to the system disclosed by Tazoe evidenced by Van Hoff.

In an analogous art, Van Hoff shows a system for displaying advertisements concurrently with browser application on a portion of a client's display. Advertisements displayed in the Ad Window (500) consist of user selectable information. Accordingly, Van Hoff shows a client application causing advertisements to be displayed on the client display.

Given this feature, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system shown by Tazoe to employ the feature

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taught by Van Hoff in order to display selected advertisements on a predefined portion of a clients display screen (see Van Hoff, col. 1 line 64- col. 2 line 5).

In referring to claim 2 and 23 Tazoe shows a method wherein the resource locator is associated with an advertisement (col. 15 lines 60-66).

In referring to claim 3, 13, and 24, Van Hoff shows the display of at least one advertisement operates in accordance with a first play list, the first play list comprising at least one ad object, each ad object comprising a resource locator for a given advertisement, a resource locator for click-through associated with the given line advertisement, at least one display attribute for the given advertisement, the first play list further specifying an order in which the advertisements are to be displayed (col. 4 lines 5-21).

In referring to claim 5, Van Hoff shows a system for client application displaying at least one advertisement in a client window displayed by the client application (Ad Window, 500, col. 3 lines 13-19).

In referring to claim 6 and 26, Tazoe shows a method for displaying advertisements to a user of an online service using a client application on a local device, wherein the client application determines that the user has not interacted with the local device with respect to the client application for a predetermined time if the user has not clicked on an advertisement in the client window within the predetermined amount of time (col. 15 lines 9-25).

In referring to claim 7 and 27, Tazoe shows client window includes a plurality of user-selectable icons, each icon being associated with a given function of the client application, and wherein the client application determines that the user has not interacted with the local device

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with respect to the client application for a predetermined amount of time if the user has not clicked on any of the icons within the predetermined amount of time (fig. 5, setup, help, end, stop, col. 16 lines 32-37).

In referring to claim 8 and 28, Tazoe shows client application establishes the communication channel by creating a physical link between the local device and the online server via a PSTN (col. 9 lines 62-64).

In referring to claim 9 and 29, Tazoe shows establishing communication channel via a modem, and though Tazoe does not explicitly show a cable modem, one of ordinary skill in the art would have readily realized this design modification in order to accommodate various communication settings.

In referring to claim 10, having some similar limitation as claim 1, Tazoe shows:

- A client application activating (col. 12 line 65- col. 13 line 3, col. 14 lines 45-47);
- A browser application activating and the browser application displaying a browser window on the output device of the local device (col. 12 lines 58-63);
- The client application monitoring the user's interaction with the window and thereby detecting whether the user is interacting with the online service, wherein interaction is manipulating the input device (col. 14 lines 51-56, col. 15 lines 4-56);
- The client application removing the window from the output device of the local device if the user has not interacted with the window for a predetermined amount of time (col. 15 lines 54-56).

Although Tazoe shows substantial features of the claimed invention, Tazoe does not show *the client application causing at least one advertisement to be displayed on the output device of*

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the local device. Nonetheless this feature is well known in the art, and would have been an obvious modification to the system disclosed by Tazoe evidenced by Van Hoff.

In an analogous art, Van Hoff shows a system for displaying advertisements concurrently with browser application on a portion of a client's display. Advertisements displayed in the Ad Window (500) consist of user selectable information. Accordingly, Van Hoff shows a client application causing advertisements to be displayed on the client display.

Given this feature, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system shown by Tazoe to employ the feature taught by Van Hoff in order to display selected advertisements on a predefined portion of a clients display screen (see Van Hoff, col. 1 line 64- col. 2 line 5).

In referring to claim 11, Tazoe shows a window is a client window displayed by the client application (col. 12 line 58-65).

In referring to claim 12, Tazoe shows method for removing client window from display, the client application re-displaying the client window on the output device if the user interacts with the browser application (col. 15 lines 3-15).

In referring to claim 15 and 16, Tazoe shows the displaying of client window on top of the browser window on the output device (fig. 6). Although Tazoe does not explicitly show the window preventing any other window from being displayed on top of the client window, this feature is a well known display design feature known to those of ordinary skill in the art. Official Notice is taken on the preventing of any other window from being displayed on top of the client window.

In referring to claim 22, Tazoe shows

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- establishing a communication channel from the local device to the online server (col. 8 lines 51-59);
- A browser application activating (col. 12 lines 58-63);
- monitoring the user's interaction with the local device with respect to client application (interaction with online service) and thereby detecting whether the user is interacting with the online service, wherein interaction is manipulating the input device (col. 14 lines 51-56, col. 15 lines 4-56);
- If the user has not interacted with the local device with respect to client application for a predetermined time, client application causing a dialog to be displayed on the output device of the local device, wherein the dialog notifies the user that the user has been idle with respect to the online server by displaying resource locator in the dialog (col. 15 lines 47- col. 16 line 8).

Although Tazoe shows substantial features of the claimed invention, Tazoe does not show *at least one advertisement to be displayed on the output device of the local device*. Nonetheless this feature is well known in the art, and would have been an obvious modification to the system disclosed by Tazoe evidenced by Van Hoff.

In an analogous art, Van Hoff shows a system for displaying advertisements concurrently with browser application on a portion of a client's display. Advertisements displayed in the Ad Window (500) consist of user selectable information. Accordingly, Van Hoff shows a client application causing advertisements to be displayed on the client display.

Given this feature, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system shown by Tazoe to employ the feature

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taught by Van Hoff in order to display selected advertisements on a predefined portion of a clients display screen (see Van Hoff, col. 1 line 64- col. 2 line 5).

Allowable Subject Matter

Claims 17-21 are allowed.

Claims 4 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 25 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita Choudhary whose telephone number is (703) 305-5268. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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December 6, 2004



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